

REMARKS

Claims 17-81 were pending when the present Final Office Action was mailed on 16 November 2006. In this response, claims 17, 23 and 56-70 have been canceled without prejudice, and claims 18-22, 24-30, 38 and 72-79 have been amended. Accordingly, claims 18-22, 24-55 and 71-81 are currently pending. The present application is a continuation application that includes claims directed to subject matter that was canceled or deleted through amendment in the parent application. The applicants reserve the right to pursue the subject matter of the originally filed claims or claims without the foregoing amendments, and/or in other forms, in a continuation application, and the applicants expressly do not disclaim any of the subject matter related to the foregoing amendments.

The Final Office Action sets forth the following objections and rejections:

- (A) Claims 52 and 67 were objected to for minor clerical errors.
- (B) The specification was objected to on the grounds that the claimed punch depths in claims 19, 25 and 58 were not disclosed.
- (C) Claims 19, 58, 62-70, 72 and 75 were rejected under 35 U.S.C. § 112, first paragraph.
- (D) Claims 17-19, 31 and 32 were rejected under 35 U.S.C. § 103(a) over the combination of U.S. Patent No. 3,962,941 (Kober) and U.S. Patent No. 4,580,374 (Quinnell).
- (E) Claims 20-22 and 33-55 were rejected under 35 U.S.C. § 103(a) over the combination of Kober, Quinnell, U.S. Patent No. 4,246,815 (Hugo), and Paragraph #006 of the original disclosure (Background Information).
- (F) Claims 23-25 and 56-58 were rejected under 35 U.S.C. § 103(a) over the combination of Kober, Quinnell, and U.S. Patent No. 4,985,119 (Vinson).

(G) Claims 26-30 and 59-61 were rejected under 35 U.S.C. § 103(a) over the combination of Kober, Quinnell, Vinson, Hugo, and the Background Information.

(H) Claims 62-64, 66-75 and 77-81 were rejected under 35 U.S.C. § 103(a) over the combination of U.S. Patent No. 2,230,043 (Moran), Kober and Quinnell.

(I) Claims 62, 65, 71 and 76 were rejected under 35 U.S.C. § 103(a) over the combination of Kober, Quinnell and U.S. Patent No. 2,225,342 (Hyatt).

A. Response to the Objection to Claims 52 and 67

Claims 52 and 67 were subject to an objection for minor clerical errors. Claim 52 has been amended to resolve the typographical error regarding the range "0.04-0.07," and claim 67 has been canceled without prejudice. Therefore, the grounds for this objection have been resolved.

B. Response to the Objection to the Specification

The specification was subject to an objection on the grounds that the claimed punch depths in claims 19 and 58 were not disclosed. More specifically, the claimed punch depth range of "0.0625-0.01875" inch was a typographical error, and the correct range should have been "0.0625-0.1875" inch as noted by the Examiner. Claim 19 has been amended to include the correct range, and claim 58 has been canceled without prejudice. The applicants accordingly request withdrawal of this objection.

C. Response to Section 112 Rejection

Claims 19, 58, 62-70, 72 and 75 were rejected under 35 U.S.C. § 112, first paragraph. Claims 58 and 62-70 have been canceled without prejudice, and thus this rejection now applies to only claims 19, 72 and 75.

Claim 19 was rejected on the grounds that the punch depth range of approximately "0.0625-0.01875" inch should correspond to the range of approximately "0.0625-0.1875

inch" described in the specification. The Examiner is correct, and claim 19 has been amended to recite that the punch depth range is "approximately 0.0625-0.1875 inch." The applicants respectfully submit that this rejection of claim 19 should be withdrawn.

Claim 72 was rejected under Section 112 on the grounds that the recitation of "allowing the at least one lateral peripheral surface to be outwardly laterally displaced" is a negative limitation not supported by the specification. The applicants respectfully disagree because this is not a negative limitation, but rather a positive recitation that the lateral peripheral surface is outwardly laterally displaced. The phrase at issue defines what the peripheral surface of the biasing element does in this embodiment as opposed to what the surface does not do. Support for this feature can be found, for example, in Figures 3A and 3B of the originally filed specification. Nonetheless, this subject matter has been canceled from claim 72 for other reasons that are not related to this rejection. The applicants respectfully submit that the rejection of claim 72 under Section 112 should also be withdrawn.

Claim 75 was rejected under Section 112 on the grounds that the phrase "at least coextensive" is not supported by the specification. The applicants respectfully disagree because this feature is clearly shown in Figures 2 and 3A, and the figures constitute part of the specification. The term "coextensive" is defined as "having the same limits, boundaries or scope." *American Heritage Dictionary of the English Language*, Houghton Mifflin and Company (2006). As best shown in Figure 3A, the length of the biasing elements 51 is the same, or at least nearly the same, as the length of the punches 50. The biasing elements in this embodiment accordingly have a length that is "at least coextensive" with the length of the punches. Therefore, the applicants respectfully request withdrawal of the rejection of claim 72 under Section 112, paragraph 1.

D. Response to Section 103 Rejection – Kober and Quinnell

Claims 17-19, 31 and 32 were rejected under 35 U.S.C. § 103 over the combination of Kober and Quinnell. Claim 19 has been rewritten in independent form to include all of

the features of claim 17, and claim 17 has been canceled without prejudice. The following remarks address independent claims 19 and 31 separately with respect to this Section 103 rejection.

1. Claim 19

Claim 19 is directed toward a method of fabricating a fiber-cement soffit comprising providing a fiber-cement panel and placing the fiber-cement panel between a punch assembly and a support assembly. The method further includes driving the punches at least substantially simultaneously into and through at least a thickness of the fiber-cement panel to form a plurality of apertures in the fiber-cement panel by ejecting plugs from the fiber-cement panel through holes in the support plate. The method, more specifically, recites that the fiber-cement panel has a thickness of approximately 0.25-0.31625 inch, and that the punches penetrate the panel to a depth of approximately 0.0625-0.1875 inch without passing the punches completely through the thickness of the panel.

Kober is directed toward an apparatus and a method for perforating and trimming filamentary boards composed of asbestos and cement to produce peg boards, rock lath, and similar perforated plates. Kober specifically discloses that his apparatus forms holes in mats having asbestos fibers held together by a hydraulic binder (i.e., a binder in a liquid state). The mat 3 disclosed in Kober is an uncured, green mat in which the liquid of the hydraulic binder has not yet been removed. Evidence supporting this is that the mat 3 must be supported by the tray 7 for the punching process because mat 3 is flexible and not rigid at this state. Moreover, Kober discloses that the lower platen 5 is formed with an array of downwardly flaring passages 19 connected to a pump 27 that withdraws liquid "expressed from the mixture of the hydraulic binder and [the] fiber forming the mat" (3:28-32). This is further evidence that the mat 3 has a high moisture content during the punching process. The mat 3, therefore, is readily deformable or flexible at this stage. Kober also expressly states that the holes 11 in the nipples 18 through which the material of the fiber mat is ejected have an inner diameter "substantially equal to the outer diameter

d of the pins 10" (3:28-39). Kober further discloses a trimming blade 25 adjacent to the punch 10 and a very small notch in the surface of an anvil strip 26. The small notch is aligned with the tip of the trim blade 25. In operation, Kober discloses lowering the tray 7 upon which the uncured mat 3 is placed until the nipples 18 are at the back side of the mat 3. The upper platen 9 is then lowered until the tip of the trim blade 25 enters the notch in the anvil strip 26 and the punches 10 reach the openings 11 in the nipples 18.

Quinnell is directed toward a soffit system that has a plastic ventilation panel 18 positioned between rigid sheets of asbestos board. Quinnell expressly discloses that the cement board should not include holes because "[T]he production of such slots [in the asbestos board] adds to the expense, which for a low-cost system using cement-based soffits can be an important factor" (col. 2, lines 30-32).

The applicants respectfully submit that the combination of features in claim 19 is patentable over Kober and Quinnell. In rejecting claim 19 over the combination of Kober and Quinnell, the Examiner states that Kober teaches punching holes through fiber-based boards, but that Kober does not specifically teach that the boards are capable of being used as soffit boards. The Examiner cites Quinnell for the proposition that it discloses a soffit system and concludes that it would have been obvious to use the punching process of Kober to form a soffit taught by Quinnell because the process in Kober would provide a rapid and economical method for producing a low-cost soffit and fascia system. The Examiner admits that Kober and Quinnell do not teach a punch depth range of 0.0625 – 0.1875 inch through only a portion of the thickness of the board, but the Examiner asserts Kober recognizes penetration depth is a result-effective variable and that it would have been obvious to determine the optimum penetration. For the reasons explained below, the applicants respectfully submit that Kober does not recognize punch penetration depth as a result effective variable and that the claimed punch depth ranges would not work in Kober's apparatus or method for forming holes in asbestos-cement mats.

Claim 19 is patentable over the combination of Kober and Quinnell under Section 103 because this combination of references fails to disclose or suggest each and every feature of this claim. For example, neither Quinnell nor Kober discloses a penetration depth range of approximately 0.0625 – 0.1875 inch through only a portion of the thickness of the board. The claimed depth range is not merely a result-effective variable because using such penetration depths in Kober would not punch holes completely through the mat described by Kober. More specifically, Kober discloses that it forms holes in an asbestos-cement mat having a "hydraulic binder," which means that the binder is in a liquid state. Kober also discloses that the mat has a sufficiently high moisture content to require a pump to remove the liquid expressed from the mat. Such a high moisture content would cause Kober's mat to be flexible or at least relatively pliable such that it would exhibit a generally linear relationship between applied stress and deformation rate instead of fracturing along crack lines. In other words, unless Kober's pins 10 pass through the mat 3, the pins 10 will only form blind recesses instead of open holes. The claimed punch penetration depth range, therefore, would not work in Kober's application because it would merely form blind recesses in Kober's moist mat. Kober accordingly requires a penetration depth through the full thickness of the mat 3 to adequately form its holes such that the penetration depth is not a "result-effective variable," but rather a necessity of the operation in Kober.

The applicants also respectfully traverse the characterization in the Office Action regarding the penetration depth of Kober's pins 10. The Examiner indicates that Kober's trim blade 25 is slightly longer than the pins 10 such that when the trim blade 25 engages the anvil strip 26, the trim blade 25 prevents the pins 10 from passing completely through the mat 3. This statement is not correct because Kober also discloses a small notch in the surface of the anvil strip 26 that is aligned with the tip of the trim blade 25 (i.e., the small line different from the cross-hatching in the anvil strip 26). This notch receives the tip of the trim blade 25 so that the trim blade 25 extends below the lower surface of the mat 3 to completely sever the edge of the mat 3. The notch in the surface of the anvil strip 26 also lengthens the stroke length of the trim blade 25 such that the tips of the pins 10 are at the

openings of the holes 11. Additionally, the tips of Kober's pins 10 are beveled such that the beveled portion of the pins 10 can enter the holes 11 even though the pins 10 and holes 11 have the same diameters. Kober's pins 10 accordingly pass completely through the thickness of Kober's mat 3. Thus, Kober does not teach passing the punches through only a portion of the thickness of the mat 3 as asserted in the Office Action.

The applicants also traverse the assertion in the Office Action that the claimed penetration depth range is merely an "optimization" of the claimed process. The claimed penetration depth of the punches is not merely an "optimization" of the claimed process, but rather addresses a problem of processing cured fiber-cement panels. Unlike the moist mat with a hydraulic binder in Kober, the inventors sought to form soffit from cured fiber-cement panels having a very low moisture content. In developing the method of claim 19, the inventors noticed delamination at the top surface of cured silica-based fiber-cement panels when the punches were passed completely through the thickness of cured fiber-cement panels. Although the downward stroke of the punches exerts the most force against the fiber-cement, the inventors hypothesized that at least a portion of the source of the delamination problem was the return stroke of the punch. However, it was not readily predictable whether small accurate holes could be punched through cured silica-based fiber-cement by passing the punch through only a fraction of the thickness of the board at the time of the invention because it was not known whether this would (a) resolve the delamination problem, (b) cause unpredictable fracture patterns resulting in nonuniform holes or insufficient board strength, or (c) adequately eject the plugs through the dies. The inventors faced this lack of predictability and developed a solution to pass the punches only part way through the thickness of the cured fiber-cement boards. This technology, however, would not work for punching holes completely through moist asbestos cement mats with hydraulic binders because such partial penetration would result in blind recesses as explained above. Therefore, it is not a mere "optimization" to form fiber-cement soffit according to the claimed punch depths, and at the time of the invention it was not predictable whether the claimed punch depths would work to form soffits from cured fiber-cement boards containing cement, silica, and cellulose fibers. The applicants respectfully

submit that the grounds for rejecting claim 19 over the combination of Kober and Quinnell have been rebutted, and therefore this rejection should be withdrawn.

Claim 19 is further patentable over the combination of Kober and Quinnell because Quinnell teaches away from using the punching process taught in Kober to form soffit. The applicants respectfully traverse the Examiner's assertion that it would have been obvious "to use the punching process taught in Kober to form the soffit boards as taught by Quinnell to provide a rapid and economical method for producing a low cost soffit and fascia system." The applicants understand, but do not necessarily concede, that the Examiner's position is that Quinnell shows that fiber-cement can be used as a soffit. The applicants, however, respectfully submit that Quinnell teaches away from using Kober's punched mat as soffit. More specifically, Quinnell states "one proposal involves the use of ventilation slots in the soffit board," but that "production of such slots [in the asbestos-cement board] adds to expense, which for a low-cost system using cement-based soffits can be an important factor." Quinnell accordingly expressly teaches away from using a fiber-cement product with preformed holes as soffit because such soffit is not low cost. This teaching of Quinnell also directly opposes the rationale set forth in the Office Action to support the assertion that Kober's fiber-cement panel would be used as soffit. Claim 19, therefore, is further patentable under Section 103 because a person skilled in the art would be dissuaded from using Kober's punched mat as a soffit based on Quinnell's teachings.

Claim 18 depends from claim 19, and therefore claim 18 is patentable over the combination of Kober and Quinnell for the reasons explained above, and also because of the additional features of claim 18. Therefore, the applicants respectfully request withdrawal of the rejection of claims 18 and 19 over the combination of Kober and Quinnell.

2. Claims 31 and 32

Claim 31 is directed toward a method of fabricating a fiber-cement soffit comprising placing a fiber-cement panel between a punch assembly and a support assembly, and

forming a plurality of apertures in the fiber-cement panel at least substantially simultaneously. Claim 31 further includes forming the apertures by driving the punches at least substantially simultaneously through only a portion of the fiber-cement panel without passing the punches completely through the thickness of the panel. Although claim 31 is different than claim 19, claim 31 is patentable over the combination of Kober and Quinnell for similar reasons because the punches do not pass completely through the thickness of the panel in claim 31. More specifically, the travel of Kober's trim blade 25 does not stop at the top of the anvil strip 26 as characterized in the Office Action, but rather the trim blade 25 is received in the notch in the surface of the anvil strip 26 such that the tips of the pins 10 pass completely through the mat 3 until they are at or in the openings of the holes 11. Claim 31 is accordingly patentable under Section 103 over the combination of Kober and Quinnell. The applicants accordingly request withdrawal of the rejection of claim 31 over the combination of Kober and Quinnell under Section 103.

Claim 32 depends from claim 31, and therefore claim 32 is patentable over the combination of Kober and Quinnell as depending from an allowable independent claim and also because of the additional features of claim 31. The applicants accordingly request withdrawal of the rejection of claim 32 as well.

E. Response to Section 103 Rejection – Kober, Quinnell, Hugo and the Background Information

Claims 20-22 and 33-35 were rejected over the combination of Kober, Quinnell, Hugo and the Background Information. Claims 20-22 depend from claim 19, and claims 33-35 depend from claim 31. Claims 20-22 and 33-35 are accordingly patentable over the combination of Kober and Quinnell alone for the reasons explained above with respect to claims 19 and 31. Hugo and the Background Information fail to overcome the shortcomings of Kober and Quinnell with respect to the punch depth in the workpiece. Both Hugo and the background information, moreover, expressly disclose punching completely through the thickness of the workpiece. Claims 20-22 and 33-35 are

accordingly patentable over the combination of Kober, Quinnell, Hugo and the Background Information for reasons analogous to those explained above.

Claims 20-22 and 33-35 are further patentable over the cited combination of references because a person skilled in the art would not modify Kober to have the claimed absolute clearances or relative clearances between the punches and the openings in the die. This rejection is based on the assertions that (a) the clearance between the punch and the hole is a result-effective variable and (b) it would have been obvious to determine the optimum absolute and relative clearance applied in the process of Kober. The applicants respectfully disagree with these assertions because Kober discloses that the optimum and perhaps the only practicable punch/die clearance for punching clean holes through Kober's moist mat 3 is approximately zero. For example, Kober expressly states that the pins 10 and holes 11 have substantially the same diameters, and Kober's purpose is to provide a tray that enables the pins 10 and holes 11 to have the same diameters without the alignment problems of the prior art. Moreover, because the mat 3 in Kober is so moist that it needs a tray for support and a pump to remove the expressed liquid, Kober's punches and die holes must have substantially the same diameter so that the opening at the die side of the board is clean. The claimed absolute and relative clearance ranges would not work for the purposes set forth in Kober because, at least in the case of Kober, the claimed ranges would not produce a clean hole through the moist mat 3. Kober, therefore, not only teaches that the die holes in the punches have substantially the same diameters, but Kober also teaches that larger clearances would not be practicable for Kober's application. The applicants respectfully submit that these facts rebut the rationale supporting the rejection set forth in the Office Action, and that it would not have been obvious to a person skilled in the art to punch holes in fiber-cement materials using the claimed absolute and relative clearances at the time of the invention. Thus, claims 20-22 and 33-35 are further patentable over the combination of Kober, Quinnell, Hugo and the Background Information under Section 103.

1. Claims 38-41

Claim 38 is directed toward a method of fabricating a fiber-cement soffit comprising providing a fiber-cement panel having a thickness of approximately 0.25-0.625 inch and placing the fiber-cement panel between a punch assembly and a support assembly. A first side of the panel faces the punch assembly and a second side of the panel faces the support assembly. The punch assembly has a punch plate with a plurality of punches coupled to the punch plate, and the support assembly has a support plate with a plurality of holes. The method of claim 38 further includes driving the punches through at least a portion of the thickness of the fiber-cement panel at least substantially simultaneously to form a plurality of tapered openings in the fiber-cement panel. The tapered openings, for example, can have a frusto-conical shape.

Claim 38 is patentable over the combination of Kober, Quinnell, Hugo and the Background Information because a person skilled in the art would not modify a board formed in accordance with the punching process of Kober to have openings of different sizes at opposite sides of the workpiece. First, because Kober's mat 3 has a hydraulic binder in a state that requires a pump to remove the expressed liquid, Kober's method of punching holes would result in holes having the same dimensions at both sides. Even if Kober used dies with openings larger than the punches, which the applicants do not concede would be practical as explained above, the holes in Kober's uncured mat 3 would not likely be tapered. This is because Kober's moist mat would not fracture ahead of the pins 10, but rather the mat would be more likely to conform to the sides of the pins 10 as they passed through the mat. This raises the question of how a person skilled in the art would modify Kober to punch holes through moist fiber cement such that the holes are tapered, but this question is not answered. Second, Kober is directed toward producing a peg board, and peg boards have openings with the same size at opposite sides of the board so that pegs can be accurately retained in the holes. It will be appreciated that tapered openings with a larger dimension on one side of the peg board would likely cause the pegs to hang at odd and/or non-uniform angles, and this would likely render the peg

board unsuitable for many applications (e.g., hanging hand tools in an organized manner). Kober, therefore, teaches away from a fiber-cement board having tapered openings.

In response to the rationale for rejecting claim 38, the applicants respectively traverse the assertion that it would have been obvious to use the punch/support arrangement taught by Hugo in the process of Kober to form tapered holes on the grounds that this arrangement would substantially reduce the breakage rate in the punching of workpieces. First, Kober is directed towards punching moist fiber-cement mats that are relatively pliable such that the punches are unlikely to break, whereas Hugo is directed toward punching thick metal pieces that are much more likely to break the punches. The rationale for combining Hugo with the process of Kober to reject claim 38, therefore, does not apply to Kober's process. Second, as explained above, Kober teaches that the pins and the die holes should have the same diameter such that the openings in the mat will have the same size on both sides of the workpiece. Third, Kober teaches away from having tapered openings because such openings would impair the utility of the final product (e.g., pegboards). The applicants accordingly submit that these downfalls of modifying Kober to have tapered openings rebut the stated rationale for combining the references as set forth in the Office Action. Claim 38, therefore, is patentable over the combination of Kober, Quinnell, Hugo and the Background Information.

Claims 39-41 are further patentable over this combination of references for the reasons explained above with respect to claims 19-22, 30-35 and 38. The applicants respectfully request withdrawal of the rejection of claims 38-41 over the combination of Kober, Quinnell, Hugo and the Background Information.

2. Claims 42-48

Claim 42 is directed toward a method of fabricating fiber-cement soffits comprising placing a fiber-cement panel between a punch assembly and a support assembly so that a first side of the panel faces the punch assembly and a second side of the panel faces the support assembly. The punch assembly has a punch plate with a plurality of punches

having a first cross-sectional dimension, and the support assembly has a support plate with a plurality of holes having a second cross-sectional dimension larger than the first cross-sectional dimension of the punches. The method further comprises driving the punches through at least a portion of the fiber-cement panel at least substantially simultaneously to form a plurality of openings in the fiber-cement panel. The openings have the first dimension of the punches at the first side of the panel and the second dimension of the holes at the second side of the panel.

Claim 42 is patentable over the combination of Kober, Quinnell, Hugo and the Background Information under Section 103 for reasons that are analogous to those explained above with respect to claim 38. Claim 42, in fact, is further patentable over this combination of references because the openings in the fiber-cement panel have a first dimension corresponding to the punches at one side of the panel and a second dimension corresponding to dimension of the holes in the support assembly at the other side of the panel. This combination of references fails to disclose at least the feature of an opening on the backside of the workpiece that has a dimension which corresponds to the size of the hole in the die because the hole formed in Hugo's workpiece does not have a second dimension equal to the size of the die hole. Referring to Figure 3 of Hugo, the size of the opening at the bottom of the workpiece is less than the diameter of the die hole 21. Claim 42 is accordingly patentable over the cited combination of references not only for the reasons described above with respect to claim 38, but also for the additional reason that the cited references fail to disclose or suggest all of the claimed features.

Claim 43-48 depend from claim 42, and therefore these claims are patentable for the reasons explained above with respect to claim 42 and also because of the additional features of these claims as explained above with respect to claims with similar features. The applicants respectfully request withdrawal of the rejection of claims 42-48 over the combination of Kober, Quinnell, Hugo and the Background Information.

3. Claims 49-55

Claim 49 is directed toward a method of fabricating fiber-cement soffit comprising providing a fiber-cement panel having a length, a width, and a thickness of approximately 0.25-0.625 inch. The method further includes placing the fiber-cement panel between a punch assembly and a support assembly, and driving the punches along a punch stroke to form a plurality of openings that have the first dimension of the punches of the first side of the panel and the second dimension of the holes at the second side of the panel. The method further includes compressing a biasing element against the first side of the fiber-cement panel as the punches move along the punch stroke.

Claim 49 is patentable over the combination of Kober, Quinnell, Hugo and the Background Information for at least the reasons explained above with respect to claim 42. Claim 49 is further patentable over this combination of references because a person skilled in the art would not modify Kober to have annular inserts around the pins 10. More specifically, because Kober's mat 3 is moist, it is in a relatively pliable state such that annular inserts surrounding the pins would likely form indentations (e.g., annular recesses) in the top surface of the mat 3 during the punching process. Such annular recesses would be undesirable because they would be unsightly on peg boards. Therefore, modifying Kober as proposed by the Examiner would result in an unsightly peg board.

Modifying the process of Kober as proposed by the Examiner to form soffit would also adversely affect the aesthetic appearance of a building. Soffit panels desirably have a flat face or wood grain on the outer surface to enhance the aesthetic appearance under the eaves. It will be appreciated that forming a soffit panel with annular indents around the openings on the external surface, as would be the case with the proposed modification of Kober, would produce an unsightly soffit. Thus, claim 49 is further patentable over the combination of Kober, Quinnell, Hugo and the Background Information under Section 103.

Claims 50-55 are patentable over the cited combination of references for the reasons explained above with respect to claim 49, and also for the reasons explained

above with respect to the additional features recited in these claims. The applicants, therefore, respectfully request withdrawal of the rejection of claims 49-55 over the combination of Kober, Quinnell, Hugo and the Background Information under Section 103.

F. Response to Section 103 Rejection – Kober, Quinnell and Vinson

Claims 23-25 and 56-58 were rejected over the combination of Kober, Quinnell and Vinson. Claims 23 and 56-58 have been canceled from this application without prejudice. The following remarks accordingly address the rejection of claims 24 and 25.

Claim 25 has been rewritten in independent form, and claim 25 has subject matter that is similar to claims 19 and 31. Claim 25 is accordingly patentable over the combination of Kober and Quinnell under Section 103 for the reasons explained above with respect to claims 19 and 31. Vinson, moreover, fails to overcome the shortcomings of the combination of Kober and Quinnell. Claim 25 is accordingly patentable over the combination of Kober, Quinnell and Vinson, and claim 24 is patentable over this combination of references as depending from independent claim 25 and also because of the additional features of claim 24. The applicants, therefore, respectfully request withdrawal of the rejection of claims 24 and 25 over this combination of references.

G. Response to Section 103 Rejection – Kober, Quinnell, Vinson, Hugo and the Background Information

Claims 26-30 and 59-61 were rejected under Section 103 over the combination of Kober, Quinnell, Vinson, Hugo and the Background Information. Claims 59-61 have been canceled from the present application without prejudice, and thus the following remarks address this rejection relative to claims 26-30.

Claims 26-30 depend from claim 25, and therefore these claims are patentable over the combination of Kober, Quinnell and Vinson as explained above. Claims 26-30 are further patentable over the combination of Kober, Quinnell and Vinson for the additional features recited in these claims. Claims 26-30 are also patentable over the combination of

references because Hugo and the Background Information fail to overcome the shortcomings of the combination of Kober, Quinnell and Vinson. As such, the applicants respectfully request withdrawal of the rejection of claims 26-30.

H. Response to Section 103 Rejection – Moran, Kober and Quinnell

Claims 62-64, 66-75 and 77-81 were rejected over the combination of Moran, Kober and Quinnell. Claims 66-70 have been canceled from the application without prejudice, and thus the following remarks address claims 71-75 and 77-81 with respect to this rejection.

Claim 71 is directed toward a method of fabricating fiber-cement soffit comprising placing a fiber-cement panel between a punch assembly positioned in a retracted position and a support assembly so that a first side of the panel faces the punch assembly and a second side of the panel faces the support assembly. The method further includes driving the punches along a punch stroke against the first side of the fiber-cement panel through at least a portion of the fiber-cement panel to form a plurality of openings therein, and compressing a resilient biasing element as the punches are driven along the punch stroke.

Claim 71 is patentable over Kober and Quinnell for reasons that are analogous to those explained above regarding compressing a resilient biasing element in claim 49. Moran fails to overcome the shortcoming of Kober and Quinnell because a person skilled in the art still would not form a soffit in accordance with the punching method of Kober using the device of Moran. More specifically, the rubber spools disclosed in Moran would likely form annular recesses in the surface of the moist mat 3 of Kober such that the resulting proposed soffit board would have annular recesses around the openings. Claim 71 is accordingly patentable over the combination of Moran, Kober and Quinnell because a person skilled in the art would not make this combination of references to come up with the claimed invention.

Claims 72-81 are patentable over this combination of references as depending from claim 71, and also because of the additional features of these claims. The applicants accordingly request withdrawal of the rejection of claims 71-81 over the combination of Moran, Kober and Quinnell.

I. Response to Section 103 Rejection – Kober, Quinnell and Hyatt

Claims 62, 65, 71 and 76 were rejected over the combination of Kober, Quinnell and Hyatt. Claims 62 and 65 have been canceled from the application without prejudice, and thus the following remarks address this rejection of claims 71 and 76.

Claim 71 is patentable over the combination of Kober, Quinnell and Hyatt for reasons analogous to those explained above with respect to the rejection of this claim over the combination of Moran, Kober and Quinnell. Claim 76 is accordingly patentable as depending from patentable independent claim 71, and also because of the additional features in claim 76. The applicants accordingly request withdrawal of the rejection of claims 71 and 76 over this combination of references.

J. Reply to the Examiner's Response to Applicants' Previous Arguments

The applicants wish to thank the Examiner for providing a detailed Office Action. Many of the assertions in the Office Action, however, have been rebutted in this paper based on scientific grounds because it appears that several aspects of Kober and punching fiber-cement products were not appreciated or given weight. In particular, the applicants respectfully traverse the assertions that the applicant has conceded that it is well known to optimize the (a) punch penetration depths and (b) absolute and relative clearances between the punch and the holes. More specifically, the punch penetration depths and the absolute and relative clearances between the punches and the holes are not merely result-effective variables or an optimization of the process for the reasons explained above in response to the rejections. The applicants expressly do not concede to

the position taken by the Examiner, and the applicants do not concede to Official Notices taken by the Examiner throughout the prosecution of this application.

The applicants also traverse the stated reason in the Office Action to support the combination of Kober and Quinnell. The applicants understand that Kober is cited as the primary reference and that Kober is used to show punching asbestos. The applicants also understand, without conceding, that Quinnell is cited as a secondary reference and that Quinnell is being used for the proposition that a fiber-cement panel can be used as soffit. The applicants, however, respectively traverse the conclusion that a person skilled in the art would use Kober's mat with punched holes to provide a low cost soffit because Quinnell expressly teaches that fiber-cement panels with slots do not provide a low-cost soffit. The applicants respectfully submit that the stated rationale for the rejection is simply not correct because it does not consider the teachings of Quinnell as a whole as required by the law under Section 103. Based on the teachings of Kober and Quinnell as a whole, there would be no reason to use Kober's punched mat as soffit. The applicants respectfully request that the Examiner reconsider this position regarding Kober and Quinnell.

In light of the foregoing, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112 and are patentable over the cited art. The applicants respectfully request reconsideration of the application and believe that the pending claims are condition for allowance. If Examiner Butler has any questions regarding the application or believes a teleconference would expedite prosecution, he is encouraged to contact the undersigned representative at (206) 259-3258.

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Respectfully submitted,

By PTP

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